

REMARKS

Applicants appreciate the careful consideration provided by the Examiner in the Office Action dated July 18, 2007. By this submission, claims 1-2, 4, and 6-11 are currently amended, while claims 3, 5, and 12 are canceled. Claims 1-2, 4, and 6-11 are therefore currently pending.

Double Patenting

Claim 5 stands objected to under 37 C.F.R. §175 as being a duplicate of claim 1. Claim 12 stands rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 3, 4, and 5 of U.S. Patent 6,686,964.

In order to expedite prosecution, Applicants have canceled claims 5 and 12. Applicants respectfully request withdrawal of the objection and rejection.

Prior Art Rejections

Claims 1-3, 5-7, and 9-11 stand rejected under 35 U.S.C. §102(e) as being anticipated by Nishitani et al, U.S. Patent 5,966,553 (hereinafter "Nishitani"). Claims 4, 8, and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nishitani in view of Hanzawa, U.S. Patent 5,506,661 (hereinafter "Hanzawa").

With respect to amended claim 1, Applicants assert that Nishitani fails to teach the features in the claim reciting:

"...displaying digital image data with no printing-specifying information onto said displaying means, such that said digital image data for which said printing-specifying information was set and said digital image data with no printing-specifying information are discriminated from each other when they are displayed on said displaying means."

Parts of the claim language above were previously recited in now-canceled claim 3. The Action states, with respect to claim 3, that Nishitani teaches the features recited therein at column 6, lines 40-52 and column 9, lines 39-50 and 36-59. A closer inspection of these passages is necessary.

The passage on column 6 merely describes the manner in which the image signal processing circuit 41, analog/digital converter 42, image data processor 44, and LCD 45 (as illustrated in Fig. 3) operate together to process signals received from the image sensor 39 to display an image in the LCD monitor 12. In summary, this passage describes parts of the camera that operate to present an image that is seen by the user on the LCD monitor 12, as the user is preparing to take a photograph. However, this passage does not describe how an image for which printing-specifying information was set and digital image data with no printing-specifying information are discriminated from each other when they are displayed on said displaying means.

The passage from column 9 can be summarized as describing the process of the camera accepting print option data entered by a user, prior to a photograph being taken. Specifically, the passage refers to how print option data 56, after a user accomplishes selecting the various print options, is then written in RAM 29. However, as with the first passage, there is nothing in the cited section, or the entire reference for that matter, which discloses how an image for which printing-specifying information was set and digital image data with no printing-specifying information are discriminated from each other when they are displayed on displaying means.

Legal Standard for Anticipation and Obviousness Rejections

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. Of California, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). As to claim 1, Applicants respectfully submit that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited reference, Nishitani, fails to teach or suggest each and every feature as set forth in the claimed invention. Applicants submit that claim 1 is allowable for at least this reason.

Claim 9 is a method claim which recites a similar novel feature not found in Nishitani, namely:

“...displaying a digital image without printing-specifying information, on a display of said digital camera, such that said digital image for which said printing-specifying information was set and said digital image without printing-specifying information are discriminated from each other.”

Applicants submit that the Office Action again fails to establish a *prima facie* case of anticipation as to claim 9 because Nishitani fails to teach or suggest each and every feature as set forth in the claim. Applicants submit that claim 9 is allowable for at least this reason.

As to each of dependent claims 2, 6-7, and 10-11, these claims are submitted to be allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Similar to anticipation rejections, in order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As to claims 4 and 8, rejected under 35 U.S.C. §103(a), Hanzawa does not supply the missing features of claim 1 that are lacking from Nishitani. Claims 4 and 8 are additionally submitted to be allowable for the reasons set forth above regarding claim 1, and/or for the further features claimed therein.

Conclusion

In view of the above amendments and remarks, Applicants respectfully assert that the pending application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact James M. Alpert, Registration. Number 59,926, at (703) 205-8062, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/730,117
Amendment dated January 16, 2008
Reply to Office Action of July 18, 2007

Docket No.: 2091-0304P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: January 16, 2008

Respectfully submitted,

By 

D. Richard Anderson

Registration No.: 40,439

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant